



Paper No. 12

BACON AND THOMAS
625 SLATERS LANE FOURTH FLOOR
ALEXANDRIA VIRGINIA 22314

COPY MAILED

FEB 18 2004

OFFICE OF PETITIONS

In re Application of

Lee

Application No. 09/640,190

Filed: August 17, 2000

Attorney Docket No. LEEV3003/WKP

:
:
: DECISION DISMISSING PETITION
: UNDER 37 CFR 1.182
:

This is a decision on the petition filed January 2, 2003, requesting under 37 CFR 1.182 a full refund of the fees for: the instant petition, the three month extension of time, and the Notice of Appeal fee, all concurrently filed.

The petition is **dismissed**. While the delay in treating the petition is regretted, it is noted that this application was only recently referred to this office.

Petitioner complains that while an amendment in reply to the final office action of July 2, 2002, was filed October 2, 2003, petitioner has become aware that the instant file and the aforementioned amendment have become lost in the USPTO, and it appears that an extended time for reconstruction of the file and its contents will be required. As such, petitioner seeks refund of the above-noted fees as applicant asserts it is impossible for him to continue prosecution. Petitioner specifically requests refund of the instant petition fee (\$130), the \$465 fee for a three month extension of time fee required under 37 CFR 1.136(a), and the \$160 fee for the Notice of Appeal.

While it is unfortunate that the file was considered lost at the time the petition was filed, such did not operate to discharge applicant from his obligation to maintain the pendency of this application, notwithstanding any proceedings related to the amendment submitted in reply to the final office action. That is, 37 CFR 1.116(a) provides in pertinent part:

After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. **The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135 (emphasis added).**

The Office delay in not treating the amendment of October 3, 2003, is unfortunate. Nevertheless, the filing of an amendment placing the application in condition for allowance is permitted under the rules (37 CFR §§ 1.113, 1.116), but entry of such an amendment is not a matter of right. While the Office attempts to promptly respond to an amendment after final, there are those instances where delays do occur, as in the instant application. However, it is clear from 37 CFR 1.116(a) that abandonment of an application is risked when an amendment after a final Office action is filed. The rule clearly indicates that the mere filing of an amendment does not relieve petitioners of the duty of taking appropriate action to save the


application from abandonment. Therefore, whether petitioner received an Advisory Action or a Notice of Allowance, in this, or in any other finally rejected application, or not, prior to the expiration of the six month statutory period, the only right petitioner was entitled to was that of appealing the final rejection or by filing a continuing application. Whether the instant application was lost in apprehension or in fact, it was applicant's obligation to maintain the pendency and consider it as being subject to appeal. See 37 CFR 1.116(a). The location of the application in the USPTO did not prevent applicant from, and indeed had no bearing on applicant's ability regarding, filing the necessary papers and pleadings--and the requisite fees. Even if the file had not been lost, it remained applicant's obligation to maintain the pendency of this application, by obtaining extensions of time and their required fees under and 35 U.S.C. 41(a)(8) and 37 CFR 1.136(a), and the Notice of Appeal and its required fee under 35 U.S.C. 41(a)(6)(a) and 37 CFR 1.191(a) while awaiting notification of the effect of the reply of October 2, 2003. See 37 CFR 1.116(a). Indeed, even if applicant's Notice of Appeal fee had been received in the USPTO on the same date the examiner had, say allowed this application, the Notice of Appeal fee would have still been owed and payable. See Meissner v. U.S., 108 USPQ 6 (D.C. Cir. 1955). Thus, the fact that this case was lost did not place applicant in any disadvantaged position with respect to the statutory (and regulatory) fee requirements of which applicant now complains. Indeed, the fees which applicant paid obtained the very result for which they were remitted: the pendency of this application was maintained.

It is noted that the Congressional intent underlying Public Law 97-247 reveals that the Commissioner is without discretion with respect to collection of the extension fees required by 35 U.S.C. 41(a)(8). See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771, 836 and instant application. 35 U.S.C. 42(d) permits refund of "any fee paid by mistake or any amount paid in excess of that required." It is not seen under the circumstances of this case, nor has petitioner shown, that the aforementioned fees were paid "by mistake." Rather, the amounts were each owed at the time each was paid, and each was paid by a duly authorized representative of the applicant. While petitioner is understandably unhappy with the way in which the amendment of October 2, 2003, was handled, the fees that were subsequently paid were required at the time each was paid, and such does not warrant refund of any of the fees, much less the appeal fee. See In re Hartman, 145 USPQ 402 (Comm'r Pat. 1965). Rather, the fact that each fee was necessary at the time it was paid warrants a conclusion that no error in payment was involved. See Meissner, Id.

37 CFR 1.182 is not a mechanism for avoiding the requirements of the established rules and procedures, see Hicks v. Costello, 1903 Dec. Comm'r Pat. 123, 125 (1903), much less the requirements of the patent statute. As such, the petition under 37 CFR 1.182 is dismissed.

This application is being returned to Technology Center AU 2674.

Telephone inquiries related to this decision should be addressed to the undersigned at (703) 305-1820.

A handwritten signature in black ink, appearing to read "Brian Hearn". The signature is fluid and cursive, with a large initial "B" and a long, sweeping underline.

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy